

REMARKS

The Applicant wishes to thank the Examiner for his examination of the present application and for the Examiner's interview of February 5 at which time the present remarks were discussed. Claims 70-75, 79, 81-83, 85-92, and 97-112 are cancelled without prejudice, the Applicants reserving the right to prosecute such claims in a follow-on application, so as to expedite allowance of the pending claims. Claims 1, 34, 76, 80, 84, and 93 have been amended. Claims 1-36, 38-69, 76-78, 80, 84, and 93-96 are currently pending. No new matter has been added.

35 U.S.C. §112

Claims 113-122 stand rejected under 35 U.S.C. §112 as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. More particular, the office action suggests that the omitted steps are: determining three-dimensional shapes of one or more articular surface of the joint; and producing an implant having a first surface and a second surface that matches the three dimensional shape of the articular surface. Claim 113 has been amended to reflect, in part: determining a three-dimensional shape of a first articular surface of the joint, the first articular surface opposing a second articular surface of the joint; and producing an implant having a first surface and second surface, the first surface opposing the first articular surface of the joint, the second surface opposing the second articular surface of the joint, wherein at least a portion of each of the first and second surfaces of the implant has a three-dimensional shape that either substantially conforms with or duplicates the shape of the first articular surface,

35 U.S.C. §102

Claims 1-36, 38-69, 76-78, 80, 84, 93-96, 113 and 115-122 stand rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. patent no. 6,652,587 (Felt et al., hereinafter Felt). Claim 1 is directed at an articular implant that includes, in part, a first surface and a second surface wherein the first surface opposes a first articular surface of a joint and the second surface opposes a second articular surface of a joint. At least a

portion of each one of the first and second surfaces of the implant has a three-dimensional shape that either substantially conforms with or duplicates the shape of the first articular surface.

Felt discloses an implant that has a tibial surface shape designed to be formed to and congruent with the tibial surface, and a generally planar femoral surface shape that is designed to include a glide path with respect to the femoral condyle (see Felt at col. 5, lines -10, and col. 13, lines 23). Nowhere does Felt disclose an implant in which at least a portion of *each* of the first and second surfaces of the implant has a three-dimensional shape that either substantially conforms with or duplicates the shape of the first articular surface, as required by amended claim 1 (emphasis added).

Since Felt fails to disclose or suggest an implant in which at least a portion of *each* one of the first and second surfaces has a three-dimensional shape that either substantially conforms with or duplicates the shape of the first articular surface, as required by amended claim 1, amended claim 1 is patentable over Felt. Claims 2-33 and 42-65 which depend from amended claim 1, are likewise patentable over Felt and are further allowable in view of the additional limitations set forth therein.

Amended independent claim 34 and dependent claims 35, 36, and 38-41; claims 66-69, which depend on claim 1 or 34; amended independent claim 76 and dependent claims 77 and 78, amended independent claims 80 and 84; and amended independent claim 93 and dependent claims 94-96 each reflect (with minor variation) that at least a portion of each of the first and second surfaces of the implant has a three-dimensional shape that substantially conforms with or duplicates the shape of the first articular surface, and thus are allowable for the same reasons as claim 1, and are further allowable in view of the additional limitations set forth therein.

It is submitted that all pending claims are in condition for allowance. Reconsideration of the claims and a notice of allowance are therefore requested.

Applicants believe that no extension of time is required; however, this conditional petition is being made to provide for the possibility that the applicant has inadvertently overlooked the need for an extension of time. Please charge deposit account 19-4972. If

any additional fees are required for the timely consideration of this application, please charge deposit account number 19-4972.

The Examiner is requested to telephone the undersigned if any matters remain outstanding so that they may be resolved expeditiously.

Respectfully submitted,

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